UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,013	02/19/2002	Joseph Philip Bigus	IBM / 201DV1	3985

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EXAMINER
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ART UNIT	PAPER NUMBER
2193	

DATE MAILED: 08/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/078,013	BIGUS ET AL.
	Examiner	Art Unit	
	Jason Mitchell	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*19 February 2002*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*19 February 2002*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/2 4/2 5/4 8/4</u> .

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____ .

DETAILED ACTION

1.   This application is a divisional of U.S. patent application 10/021,203 filed on 10-

30-2001.

2.   Claims 1-20 are pending in this case.

Information Disclosure Statement

3.   The information disclosure statements filed 2/19/02, 5/24/04, and 8/9/04 fail to

comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign

patent document; each non-patent literature publication or that portion which caused it

to be listed; and all other information or that portion which caused it to be listed. It has

been placed in the application file, but the information referred to therein has not been

considered.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 8-20 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

The language of claim 8-14 raises a question as to whether the claim is directed merely

to an abstract idea that is not tied to a technological art, environment or machine which

would result in a practical application producing a concrete, useful, and tangible result to

form the basis of statutory subject matter under 35 U.S.C. 101. Independent claim 8

recites the limitation 'a memory', but does not explicitly state that this memory is a

'computer readable memory'. Nor do any of the other limitations necessitate the use of

a computer as in claim 1 (i.e. program code). While it is likely that one of ordinary skill in

the art would recognize the claimed method to be computer implemented, some

clarification is required.

Claims 15-20 are not limited to tangible embodiments. In view of Applicant's disclosure,

specification page 15, line 2, the medium is not limited to tangible embodiments, instead

being defined as including both tangible embodiments (e.g., optical disks) and intangible

embodiments (e.g., communication links). As such, the claim is not limited to statutory

subject matter and is therefore non-statutory.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-4, 6-11, and 13-15 are rejected under 35 U.S.C. 102(b) as being

anticipated by US 6,115,549 to Janis et al (Janis).

Regarding Claims 1 and 8: Janis discloses an apparatus, comprising: (a) a memory

within which is resident a plurality of intelligent agents (Fig. 4, Memory Device) and

distribution control information associated with each intelligent agent that defines

distribution rights for such intelligent agent (col. 9, lines 25-33 'Distribution-controlling

data'); and (b) program code configured to control distribution of an intelligent agent in response to a request to access such intelligent agent based upon the distribution control information associated with such intelligent agent (col. 9, lines 49-54 'review a distribution list').

Regarding Claims 2 and 9: The rejection of claims 1 and 8 are incorporated, respectively; further Janis discloses the program code is further configured to set distribution control information for an intelligent agent in connection with publishing the intelligent agent (col. 13, lines 60-63 'the determination step ... as part of a publication 246').

Regarding Claims 3 and 10: The rejection of claims 2 and 9 are incorporated, respectively; further Janis discloses the distribution control information is disposed in a header for each intelligent agent (col. 9, lines 25-33 'Distribution-controlling data 80').

Regarding Claims 4 and 11: The rejection of claims 1 and 8 are incorporated, respectively; further Janis discloses the distribution control information defines a publishing level that prohibits distribution of an intelligent agent to another computer (col. 9, lines 49-54 'review a distribution list 154 to determine whether or not ... to receive a distribution of a software object').

Regarding Claims 6 and 13: The rejection of claims 1 and 8 are incorporated, respectively; further Janis discloses the plurality of intelligent agents are each configured to perform product support operations in connection with supporting a computer-related product (col. 14, lines 36-37 'maintenance methods'), and wherein the distribution control information identifies a first intelligent agent as an internal agent

configured to execute on a product support computer (col. 14, lines 19-22 'destination node 52 ... remote from the workstation node 58 conducting the actual distribution'), and a second intelligent agent as an external agent configured to execute on a customer computer configured to utilize the computer-related product (col. 14, lines 17-19 'destination node 52 ... distributing a software object 100 to itself').

Regarding Claims 7 and 14: The rejection of claims 6 and 13 are incorporated, respectively; further Janis discloses the distribution control information further identifies a third intelligent agent as a base agent associated with a particular release of the computer-related product (col. 14, lines 44-49 'maintenance methods 254 include monitoring ... the distribution methods').

Regarding Claim 15: Janis discloses a program product, comprising: (a) an intelligent agent (col. 14, lines 36-37 'maintenance methods'); (b) a header associated with the intelligent agent (col. 9, lines 25-33 'Distribution-controlling data 80'), the header including distribution control information that defines distribution rights to the intelligent agent (col. 9, lines 49-54 'review a distribution list'); and (c) a signal bearing medium bearing the header and the intelligent agent (Fig. 4, Memory Device).

Regarding Claim 18: Janis discloses a program product, comprising: (a) program code configured to control distribution of an intelligent agent in response to a request to access such intelligent agent by accessing distribution control information associated with such intelligent agent, wherein such distribution control information defines distribution rights for such intelligent agent (col. 9, lines 49-54 'review a distribution list'); and (b) a signal bearing medium bearing the program code (Fig. 4, Memory Device).

Regarding Claim 19: The rejection of claim 18 is incorporated; further Janis discloses

the signal-bearing medium includes at least one of a transmission medium and a

recordable medium (Fig. 4, Memory Device).

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   **Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable**

over US 6,115,549 to Janis et al.

Regarding Claims 5 and 12: The rejection of claims 1 and 8 are incorporated,

respectively; further Janis does not explicitly disclose a publishing level that permits

distribution only in response to authorization from product support personnel.

However, Janis does disclose distribution properties that are only available to support

personnel (col. 15, lines 57-63 'properties ... only available to a system administrator')

and that these properties include distribution rights (col. 15, lines 54-56 'distribution

parameters 150 ... may be properties'). Additionally, Janis discloses providing a means

to contact product support personnel (col. 10, lines 45-49 'Each contact record ... a

person responsible for implementing a distribution').

It would have been obvious to a person of ordinary skill in the art at the time of the

invention to provide a system where a potential recipient of the intelligent agent would

be provided access to the agent only after contacting support personal (col. 10, lines 45-49 'a person responsible for implementing a distribution'), and convincing said support personal to alter the rights (col. 15, lines 57-63 'properties ... only available to a system administrator') thereby providing additional control and flexibility to the distribution system.

9.   **Claims 16-17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over "The Open Software Description Format" (OSD) by Hoff et al.**

Regarding Claim 16: The rejection of claim 15 is incorporated; further Janis does not explicitly disclose the header is defined in a markup language.

OSD teaches using XML (Abstract 'OSD, an application of the eXtensible Markup Language') for the purposes of managing metadata regarding software distribution (Abstract 'We expect OSD to be useful in automated software distribution').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to manage Janis's distribution-control data (col. 9, lines 25-33 'Distribution-controlling data') using XML as taught by OSD (Abstract 'OSD, an application of the eXtensible Markup Language') if it were determined that Janis's directory service (Abstract 'A directory services system is responsible for maintaining ... a distribution object') was not desirable.

Regarding Claim 17: The rejection of claim 16 is incorporated; further OSD discloses the header is defined in XML (Abstract 'OSD, an application of the eXtensible Markup Language').

Regarding Claim 20: The rejection of claim 18 is incorporated; further Janis discloses

the program code is configured to access the distribution control information for such

intelligent agent by accessing a header associated with such intelligent agent (col. 9,

lines 25-33 'Distribution-controlling data 80'), but does not disclose the header is

defined in a markup language.

OSD teaches using XML (Abstract 'OSD, an application of the eXtensible Markup

Language') for the purposes of managing metadata regarding software distribution

(Abstract 'We expect OSD to be useful in automated software distribution').

It would have been obvious to a person of ordinary skill in the art at the time of the

invention to manage Janis's distribution-control data (col. 9, lines 25-33 'Distribution-

controlling data') using XML as taught by OSD (Abstract 'OSD, an application of the

eXtensible Markup Language') if it were determined that Janis's directory service

(Abstract 'A directory services system is responsible for maintaining ... a distribution

object') was not desirable.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. 2004/0059929 to Rodgers et al. discloses methods of digital Rights

Management; US 5,933,647 to Aronberg et al. discloses a method of software

distribution, further references cited in 10/021,203 from which the instant application is a

divisional are considered relevant to the extent they disclose aspects of the intelligent

agents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Mitchell
8/03/05

ANIL KHATRI
PRIMARY EXAMINER